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OFFICE OF PETITIONS

In re Application of :
Saito, et al. : ON PETITION
Application No. 10/827,323 :
Received April 20, 2004 :
Docket No.: 113539.01 :

This is a decision on the "PETITION UNDER 37 CFR § 1.53(e)(2)" filed October 28, 2004. This petition is being treated as a request for reconsideration on the merits of the decision on petition mailed October 1, 2004.

The application was received by the USPTO on April 20, 2004. On June 30, 2004, a Notice to File Missing Parts of Nonprovisional Application ("Notice") was mailed indicating, *inter alia*, that the application had been accorded a filing date but that figure 18 appeared to have been omitted from the application as filed.

The Notice permitted applicant to either: (1) promptly establish prior receipt in the PTO of the omitted items at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the items in question were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted items and accept the date of such submission as the application filing date must file any omitted items with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the Notice (37 CFR 1.181(f)).

In response to the Notice, a petition was filed October 14, 2003 requesting withdrawal of the Notice; acknowledgement that Fig. 18 was received on April 20, 2004; and a filing date of April 20, 2004 with Figure 18 as part of the original disclosure.

A decision on the petition was mailed October 1, 2004 and is hereby incorporated by reference¹.

In the instant request for reconsideration, petitioners argue that figure 18 should be entered into the application on the grounds that figure 18 is question is part of the disclosure of U.S. App. No. 10/226,305.

Whereas petitioners previously argued that a postcard established *prima facie* receipt of the figure in question, petitions are now arguing that based on the theory of incorporation by reference, figure 18 should be entered into the record and the application be accorded a filing date of April 20, 2004.

It is noted that the first page of the specification of the instant application contains an incorporation statement. An incorporation by reference statement may be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition, provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference. See, MPEP 201.06(c).

Based on petitioner's representation that figure 18 is part of the disclosure of application No. 10/226,305 and the entire disclosure of application No. 10/226,305 was specifically incorporated by reference into the present application on April 20, 2004, it appears that figures 18 was present in the Office on April 20, 2004, albeit in the file of another application, i.e., application No. 10/226,305. Petitioner therefore may be accorded the requested filing date.

Figure 18, however, will not be entered into the record by the instant petition because as indicated herein, a petition is not necessary for this purpose.

¹ Petition dismissed as to entry of the drawing figure in question; petition granted as to accordance of a filing date of April 20, 2004.

If deemed appropriate, petitioners are advised to promptly submit a preliminary amendment requesting entry of the omitted figure prior to the issuance of the first Office action on the merits.

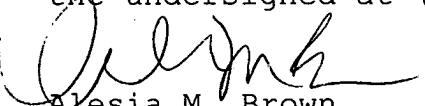
A newly executed oath or declaration is not required under 37 CFR 1.51(b)(2) and 1.53(f) in a continuation or divisional application, provided that the specification and drawings filed in the continuation or divisional application contain no matter that would have been new matter in the prior application. See 37 CFR 1.63(d)(1).

The required petition fee of \$130.00 will not be refunded since the petition was necessary to correct petitioner's filing error.

In view of the above, the petition is **DISMISSED**.

As no further action by the Office of Petitions is deemed necessary at this time, this application is being returned to the Office of Initial Patent Examination for further processing with a filing date of April 20, 2004 using the papers present on that day and without entry of Fig. 18.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3205.



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